

III. REMARKS

1. Applicant respectfully notes that it has failed to receive a decision related to the pre-appeal brief conference request filed on October 9, 2007. A review of the PAIR site has not identified the decision. The Examiner is requested to forward a copy of the decision to Applicant.

2. Claims 1-5, 7-13, 15, 17-32 and 34-35 are not unpatentable over Byrne in view of Huang and Tang et al. ("Tang") (U.S. Pub. No. 2002/0188740) under 35 U.S.C. §103(a).

As noted in the prior responses, the combination of Byrne and Huang does not disclose or suggest each feature recited by Applicant in the claims. The combination of these references with Tang also does not disclose or suggest each and every feature recited by Applicant in the claims.

Claim 1 recites that a criterion for the intersystem handover is one of a requested content, a requested access point name, a requested uniform resource location and a requested Internet protocol address. With respect to Byrne, the examiner states that Byrne discloses that the transmission comprises "information" indicating that an intersystem handover should be performed where the information is based on one of a requested content, a requested access point number. Byrne does not disclose that a "criterion" for the intersystem handover is "one of a requested content, a requested access point name, a requested uniform resource location and a requested Internet protocol address." Byrne only discloses that a transmission includes "information" that the handover should be performed. Byrne does not disclose elements that form a "criterion" for the handover has claimed by Applicant. "Information" involved in an intersystem handover is not the same as a "criterion" for an intersystem handover. Thus, at least this feature is not disclosed or suggested by Byrne.

Additionally Byrne does not disclose a "requested access point number" being a "criterion" for an intersystem handover. The examiner refers to Col. 7, lines 50-60 of Byrne. However this passage does not make any mention of access point numbers.

This passage also does not disclose or suggest that a "criterion" as to whether or not a handover is to be performed is based on a "requested access point number" as claimed by Applicant. Col. 7, lines 50-60 only discloses that the link 530 has an information bandwidth. The bandwidth is capable of transmitting the necessary control signals to facilitate automatic paging and handover between systems. There is no disclosure here related to "access point numbers" or that access point numbers are a "criterion" for a handover. In fact, this section of Byrne does not discuss any criterion for a handover. The approach of Byrne is rather a flag indicating, on a general basis, that a terminal is "in a preferred system" which triggers a handover. (Col. 8, lines 5-14). Thus, at least this element claimed by Applicant is not disclosed or suggested by Byrne.

The Examiner states that Huang discloses that "information" is based on a requested Internet protocol address and that this reads on the elements of Applicant's claim 1. It is submitted that this interpretation is incorrect. Applicants claim 1 recites that "criterion" for the intersystem handover is one of a requested content, a requested access point name, a requested uniform resource location and a requested Internet protocol. Huang does not disclose "**criterion**" for a handover as claimed Applicant. Col 3, lines 35-40 of Huang discusses the organization of the nodes into VLANs. When a node desires to communicate with a node on a different VLAN an address resolution protocol request packet containing the IP address of the destination node is transmitted. There is no disclosure here related to a "**criterion**" for an intersystem handover being based on a "requested Internet protocol address" as recited by Applicant in the claims. The reference by Huang to an IP address is only for routing purposes and is not within the scope of a "**criterion**" for a handover. Huang does not disclose or suggest that a decision on whether or not a handover is to be performed is to be based on a requested Internet protocol address. Thus, at least this element claimed by Applicant is not disclosed or suggested by Huang.

Examiner notes the neither Byrne nor Huang discloses or suggests that a "criterion" for the intersystem handover is a requested content. Tang is referred to as teaching this element. It is submitted that this is not correct.

First, there is no motivation to combine Tang with Byrne and Huang. Tang is related to TCP/IP protocols and the TCP handoff protocol. Tang specifically relates to the selection of a server of a Web server cluster. This has no relationship to the selection of a radio access network that is to be used by a mobile terminal for accessing a communication network as recited by Applicant's claims. Tang does not disclose or suggest the selection of an access point of some terminal to the Internet. Routing within the Internet relates to a different art than the radio interface employed for mobile communications. Thus one of skill in the art dealing with mobile terminals in a communications network would not even consider the Tang reference in an effort to achieve the subject matter and elements claimed by Applicant.

While the Examiner states that the motivation would be to "increase the system flexibility", it is submitted that this is merely a broad omnibus statement of no particular relevance. As noted in the recent developments related to obviousness law, there must be some tangible reason to combine references. Mere speculation is not sufficient. Motivation under 35 U.S.C. §103(a) requires a specific reason to combine the references. "System flexibility" is not a reason. It can only be considered a statement of a benefit that might be realized, and is not, and cannot be, a reason why one would look from the combination of Byrne and Huang to Tang, in an effort to achieve what is claimed by Applicant. At most, it would only be with hindsight knowledge of Applicant's claimed subject matter that one would realize "system flexibility" as a potential advantage of the combination. However, without some further suggestion to combine these references, this does not satisfy the requirements for 35 U.S.C. §103(a).

It is also respectfully submitted that Byrne, Huang and Tang have been combined improperly. References may be combined under 35 U.S.C. §103(a) only if the references are analogous art. In this case Byrne, Huang and Tang are not analogous art. A reference is analogous art if:

- 1) *The reference is in the same field of endeavor as the applicant's, or*

- 2) *The reference is reasonably pertinent to the particular problem with which the applicant was concerned.*

Tang relates to the selection of a server of a Web server cluster. Tang allows for the handing off of the TCP states between nodes in an associate network that is optimized for handoff of TCP states. Byrne, on the other hand, is directed to a radio telephone system where a radio telephone automatically hands over a call from one radio telephone system to another radio telephone system. Huang deals with implementing virtual local area networks. Applicant's claimed subject matter is directed to initiating an intersystem handover of a mobile terminal accessing a communication network. Tang is clearly not in the same field of endeavor as Applicant's and is not directed to the particular problem that is solved by Applicant's claimed subject matter. Thus, Tang is not analogous art and cannot be combined with Byrne and Huang for purposes of 35 USC §103(a).

Tang also does not teach that a "**criterion**" for intersystem handover is a requested content. Paragraph 0015 of Tang discusses the TCP handoff mechanism for the distribution of HTTP web requests. This is not the same as what is claimed by Applicant.

Thus, it is submitted that neither Byrne, Huang nor Tang disclose each and every element recited by Applicant in the claims. Therefore, the combination cannot as well.

In view of the foregoing, a *prima facie* case of obviousness under 35 USC §103(a) has not been established. Therefore, claim 1 is not unpatentable over the combination of Byrne, Huang and Tang.

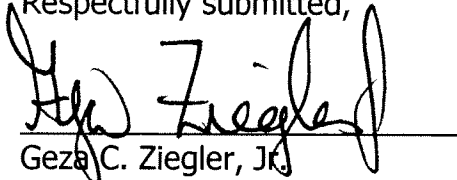
Claims 22, 26, 32 and 34 are also not unpatentable for similar reasons. Claims 2-5, 7-13, 15, 17-21, and 23-31 should be allowable at least by reason of their respective dependencies.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now we are present in the application are clearly novel and patentable over the prior art of

record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


Geza C. Ziegler, Jr.
Reg. No. 44,004

29 Jan 2008
Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800
Customer No.: 2512

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being transmitted electronically on the date indicated below and addressed to Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: 29 Jan. 2008

Signature: Francis J. New